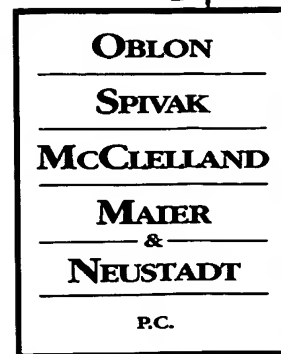




Docket No.: 274669US0PCT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

RE: Application Serial No.: 10/542,850
Applicants: Hans-Detlef LUGINSLAND, et al.
Filing Date: June 13, 2006
For: SPECIALLY PRECIPITATED SILICIC ACIDS FOR
RUBBER APPLICATIONS
Group Art Unit: 1755
Examiner:

SIR:

Attached hereto for filing are the following papers:

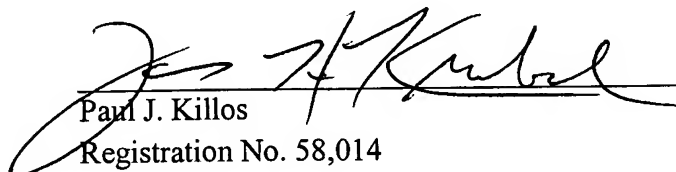
Letter

International Preliminary Report on Patentability

Our check in the amount of \$0 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon


Paul J. Killos
Registration No. 58,014

Customer Number

22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)

James H. Knebel
Registration No. 22,630



DOCKET NO: 274669USOPCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
HANS-DETLEF LUGINSLAND, ET AL. :
SERIAL NO: 10/542,850 :
FILED: JUNE 13, 2006 : GROUP ART UNIT:
FOR: SPECIALLY PRECIPITATED :
SILICIC ACIDS FOR RUBBER
APPLICATIONS

LETTER

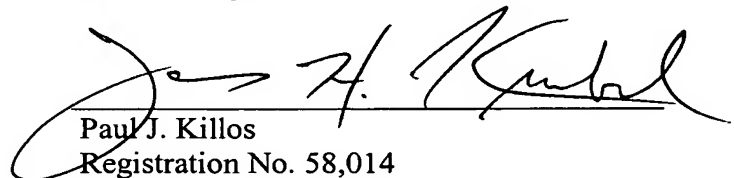
COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants wish to make of record the attached English translation of the International Preliminary Report on Patentability. Copies of the references listed therein were filed on October 20, 2005.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon


Paul J. Killos
Registration No. 58,014

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

James H. Knebel
Registration No. 22,630

PATENT COOPERATION TREATY

PCT/EP2004/050004

D. Wolf

H00033371Y

From the INTERNATIONAL BUREAU

PCT

NOTIFICATION OF TRANSMITTAL
OF COPIES OF TRANSLATION
OF THE INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(CHAPTER I OR CHAPTER II
OF THE PATENT COOPERATION TREATY)
(PCT Rules 44bis.3(c) and 72.2)

DEGUSSA AG
Intellectual Property Management
PATENTE-MARKEN
Bau 1042 - PB 15
45764 Marl
ALLEMAGNE

Date of mailing (day/month/year)

12 October 2006 (12.10.2006)

Applicant's or agent's file reference
O.Z. 6286-WO

IMPORTANT NOTIFICATION

International application No.
PCT/EP2004/050004

International filing date (day/month/year)
08 January 2004 (08.01.2004)

Applicant

DEGUSSA AG et al

1. Transmittal of the translation to the applicant.



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter I).



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter II).

2. Transmittal of the copy of the translation to the designated or elected Offices.

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following designated or elected Offices requiring such translation:

KR

The following designated or elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

AE, AG, AL, AM, AP, AT, AU, AZ, BA, BB, BG, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EA, EC, EE, EG, EP, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NA, NI, NO, NZ, OA, OM, PG, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW

3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability (Chapter II).

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned within the applicable time limit (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.

The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Authorized officer

Ellen Moyse

Facsimile No. +41 22 338 82 70

Facsimile No. +41 22 338 82 70

TRANSLATION

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference O. Z. 6286-WO	FOR FURTHER ACTION See Form PCT/IPEA/416	
International application No. PCT/EP2004/050004	International filing date (day/month/year) 08.01.2004	Priority date (day/month/year) 22.01.2003
International Patent Classification (IPC) or national classification and IPC C01B33/193, C08K3/36, C09C1/30, B60C1/00, B60C17/00		
Applicant DEGUSSA AG		

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 6 sheets, including this cover sheet.

3. This report is also accompanied by ANNEXES, comprising:

a. ☒ (sent to the applicant and to the International Bureau) a total of 6 sheets, as follows:

☒ sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).

☐ sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.

b. ☐ (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).

4. This report contains indications relating to the following items:

<input checked="" type="checkbox"/>	Box No. I	Basis of the report
<input type="checkbox"/>	Box No. II	Priority
<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
<input type="checkbox"/>	Box No. IV	Lack of unity of invention
<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
<input type="checkbox"/>	Box No. VI	Certain documents cited
<input type="checkbox"/>	Box No. VII	Certain defects in the international application
<input type="checkbox"/>	Box No. VIII	Certain observations on the international application

Date of submission of the demand	Date of completion of this report
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/050004

Box No. I

Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language _____ which is the language of a translation furnished for the purposes of:
- ☐ international search (Rule 12.3 and 23.1(b))
- ☐ publication of the international application (Rule 12.4)
- ☐ international preliminary examination (Rule 55.2 and/or 55.3)
2. With regard to the elements of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:
- ☐ the international application as originally filed/furnished
- ☒ the description:
- pages 1-33 _____ as originally filed/furnished
- pages* _____ received by this Authority on _____
- pages* _____ received by this Authority on _____
- ☒ the claims:
- nos. _____ as originally filed/furnished
- nos.* _____ as amended (together with any statement) under Article 19
- nos.* 1-23 _____ received by this Authority on 07.06.2005 with letter
- nos.* _____ received by this Authority on of 01.06.2005
- ☐ the drawings:
- sheets _____ as originally filed/furnished
- sheets* _____ received by this Authority on _____
- sheets* _____ received by this Authority on _____
- ☐ a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages _____
- ☐ the claims, nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages _____
- ☐ the claims, nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____

* If item 4 applies, some or all of those sheets may be marked "superseded."

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/050004

Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	
1. Statement		
Novelty (N)	Claims <u>1-23</u>	YES
	Claims _____	NO
Inventive step (IS)	Claims <u>1-23</u>	YES
	Claims _____	NO
Industrial applicability (IA)	Claims <u>1-23</u>	YES
	Claims _____	NO
2. Citations and explanations (Rule 70.7)		
<p>This report makes reference to the following documents:</p>		
<p>D1: EP-A-0 983 966 (DEGUSSA-HUELS AKTIENGESELLSCHAFT; DEGUSSA AG) 8 March 2000 (2000-03-08)</p>		
<p>D2: EP-A-0 901 986 (DEGUSSA-HUELS AKTIENGESELLSCHAFT; DEGUSSA AG) 17 March 1999 (1999-03-17)</p>		
<p>D3: EP-A-0 755 899 (DEGUSSA- AKTIENGESELLSCHAFT) 29 January 1997 (1997-01-29)</p>		
<p>D4: WO 96/35639 A (PPG INDUSTRIES, INC) 14 November 1996 (1996-11-14)</p>		
<p>D5: EP-A-0 745 558 (DEGUSSA AKTIENGESELLSCHAFT; DEGUSSA-HUELS AKTIENGESELLSCHAFT) 4 December 1996 (1996-12-04)</p>		
<p>D6: EP-A-0 407262 (RHONE-POULENC CHIMIE) 9 January 1991 (1991-01-09)</p>		
<p>The present application claims precipitated silicic acids defined by specific parameter ranges (claims 1-8). The claimed precipitated silicic acids can be</p>		

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/050004

Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

modified using organosilanes (claims 18 and 19). The methods for producing these precipitated silicic acids are claimed in claims 9-17 and 20.

The possibilities for their use are disclosed in claims 21 and 22.

Claim 23 claims a vulcanizable rubber mixture containing the non-surface-modified precipitated silicic acids.

D1 is regarded as the prior art closest to the subject matter of claim 1.

D1 discloses a precipitated silicic acid having the following physicochemical data:

- BET surface area: 80-180 m²/g
- CTAB surface area: 80-139 m²/g
- BET/CTAB ratio: 1.0-1.6
- Sears number: 5-25 ml
- DBP number: 200-300 ml/100g

D4 (page 16, line 28 to page 17, line 3) shows that precipitated silicic acids normally contain 1-7 percent by weight moisture. This is confirmed by D5 and D6 (see D5, page 8, lines 1-12; D6, examples 1-3).

Therefore, the moisture is regarded as being implicitly disclosed in D1.

The precipitated silicic acids can also be surface-

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/050004

Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

modified using organosilanes (D1, claims 11 and 12;
page 6, line 2 to page 8, line 10).

The precipitated silicic acids can be mixed into
vulcanizable rubber mixtures as a reinforcing
filler.

D1 differs from the subject matter of present claim
1 in that it does not claim a ratio of Sears number
to BET surface area.

In view of D1, present claim 1 appears to be a
selection invention.

An invention is considered a selection invention
when the following three requirements have been
fulfilled:

- There is no technical effect.
- The examples in the prior art are sufficiently far
removed from the embodiments of the present
invention.
- A sufficiently narrow scope is claimed as compared
to the scope described in the prior art.

The precipitated silicic acid according to claim 1
of the present application differs essentially from
the examples in D1, since the feature "ratio of
Sears number to BET surface area" is greater, which
means that the precipitated silicic acids in D1 have
fewer OH groups per square meter of surface area.

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/050004

Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

The applicant has demonstrated surprising technical effects over the prior art. These technical effects are increased rubber activity, very good dispersion behavior and shorter vulcanization time.

These three requirements and therefore the criterion in PCT Article 33(2) and (3) appear to be satisfied by the present claim 1.

Consequently, the subject matter of claim 1 can be regarded as novel and inventive (PCT Article 33(2) and (3)).

Claims 2-8, 18 and 19 are dependent on claim 1 and therefore likewise meet the PCT requirements for novelty and inventive step, as do the method claims 9-17 and 20 and the use claims 21-23.